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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,192	05/23/2000	Kia Silverbrook	NPA048US	9205

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER	
GRANT II, JEROME	
ART UNIT	**PAPER NUMBER**
2626	

DATE MAILED: 10/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/575,192	SILVERBROOK ET AL.	
	Examiner	Art Unit	
	Jerome Grant II	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-154* is/are pending in the application.

4a) Of the above claim(s) *29-154* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

JEROME GRANT II
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s) _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Detailed Action

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, 14-17, 19, 20 and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemelson.

With respect to claims 1 and 14 Lemelson teaches a method of providing a copy of at least one page of a printed document, the document including coded data (25) indicative of the identity of the document (21) and of at least one reference point of the document (right margin),

the method including the steps of: receiving, in a computer system, (39N or 30) indicating data from a sensing device 39A, 39C - by a user (col. 5, lines 60-65) indicating the position of the sensing device relative to the document ; identifying the computer system (col. 5, lines 50-60) and a request for a copy of a page of a document (col. 6, lines 5-10); and transmitting, from the system relevant document data to at least a printer for effecting a print (col. 9, lines 42-51).

With respect to claims 2 and 15, Lemelson teaches a zone of a document (right margin) having information associated with the copy of a page and used to identify the zone where a sensing device is located. See figures 3 and 5.

With respect to claim 3, Lemelson teaches the receiving step as claimed in accordance with step 74 and 77 of figure 10. See also col. 4, lines 10-17. Lemelson teaches identification a request for copy in the zone. See sensing of magnetic information on sheet. See col. 4, lines 22-27 and 37-42.

With respect to claim 4, Lemelson shows method using a printed document 21 with line coded data 25 indicative of a request including the steps of:

receiving, a sensing device (39A, 39C) operated by a user (col. 5, lines 60-65) so that the document is positioned relative to the sensors (col. 4, lines 5-27); and transmitting relevant document data to effect printing, see col. 9, lines 42-51.

With respect to claim 5, Lemelson shows providing a copy of a page 21 with coded data 25 including the steps of receiving in a computer system a sensing device (39a, 39c) operated by a user (coll 5, lines 60-65) so that the documents move relative to the sensing device (col. 4, lines

5-27); interpreting a movement of a sensing device as designating the request (via microprocessor 30 or computer 39N); and transmitting relevant document data to at least one printer (see col. 9, lines 42-51).

With respect to claim 6, Lemelson teaches a method of copying at least one document 21 including coded data 25, the method including: receiving in a computer system (39N or 30) data from a sensing device 39A, 39C regarding ID of a user (user of printer having predetermined ID according to col. 4, lines 45-52), this information containing the ID of the user and the sensor of the computing device which identifies a document having the coded data 25; identifying document (Col 5, lines 50-60 and col. 6, lines 5-10) and transmitting relevant document data to a printer (see col. 9, lines 42-51). Print request data is addressed at col. 6, lines 6-14, see also col. 9, lines 40-50.

With respect to claim 7, the coded data appears in the margin of document 21 as data 25. Sensing device 39A and 39C reads the coded data.

With respect to claim 8, see col. 4, lines 5-27.

With respect to claim 9, see col. 9, lines 42-51.

With respect to claim 10, data exists on the magnetic strip. The data on the strip is invisible since it is digitally represented.

With respect to claim 11, the identification means is the microprocessor in accordance with col. 7, lines 9-15) which gives a unique identity of a user see also col. 4, lines 45-52.

With respect to claim 12, see col. 9, lines 40-50.

With respect to claim 16, see step 74 and 77 and fig. 10 of Lemelson. See also col. 4, lines 9-27.

With respect to claim 17, Lemelson teaches a computer system 39N or 30 for receiving data from sensors 39A or 39C by a user (col. 5, lines 50-60); the sensor sensing coded data 25 and the system making printed copies (see col. 9, lines 42-51)

With respect to claim 19, Lemelson teaches a system for printing documents 21 including coded data 25, the system including: a computer system 39N or 30 for sensing data (39A or 39C) regarding the identity of a user (see col. 5, lines 50-60) as the document is moved relative to the sensor. Lemelson teaches sensing data in the magnetic strip portion of 25; the computer system being configured to transmit relevant document using the coded data document data being sent to a printer as discussed at col. 4, lines 22-27 and 37-42.

With respect to claim 20, see col. 4, lines 20-27.

With respect to claim 21, see the sensing devices 39A and 39C.

With respect to claim 22, Lemelson teaches the sensing device 39A and 39C recognizes marks on a magnetic nib.

With respect to claim 23, Lemelson teaches unique identity information for a user according to col. 3, line 60- col. 4, line 5. See also col. 4, lines 45-52.

With respect to claims 24-26 ,see col. 2, lines 10-15; col. 5, lines 52-55 and col. 9, lines 41-48.

With respect to claim 27, see the digital data recorded on the magnetic strip.

With respect to claim 87, Lemelson teaches a method to enable a person to make a copy of at least one part of a physical object (document with coded data on it), such as document 21 which includes coded data 25, the method including: providing a person with the physical object (user who has document 21 with the coded data 25 in his possession); receiving, in a computer system (39N or 30) data from a sensing device 39A, 39C regarding ID of a user (user of printer having predetermined ID according to col. 4, lines 45-52), this information containing the ID of the user and the sensor of the computing device which identifies a document having the coded data 25; and identifying in the computer system (39N or 30) document data which is described at col 5, lines 50-60 and col. 6, lines 5-10) and transmitting relevant document data to a printer (see col. 9, lines 42-51). Note that data which identifies the user is the voice data referred to at col. 5, lines 63- col. 6, line 14.. The voice synthesizer identifies the user
The copy request at least identifies the document. Print request data is addressed at col. 6, lines 6-14, see also col. 9, lines 40-50.

With respect to claim 138, Lemelson teaches a system shown by figures 4 and 5 to enable a person to make a copy of at least a document (21) and coded data (25), the coded data used to

identify the object: the system including a computer system 39N or 30 the system including: a computer system 39A or 30 for receiving from a sensing device data indicative of an identity of the person (voice pattern identification) and the identity of the document (represented as data 25). Print request data is addressed at col. 6, lines 6-14, see also col. 9, lines 40-50.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13, 18, 21, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson in view of the Well Known Prior Art 2144.03.

Regarding claims 13 and 28, Lemelson teaches all of the limitations upon which the claim depends except for binding the pages.

However, this limitation is obvious in view of printers which are well known to have a staple means. In other words, the printer makes the prints of a plurality of sheets and binds them by means of a stapler. This is a common feature with printer and copiers and would have been recognized by one of ordinary skill in the art.

Regarding claim 18 and 21, Lemelson teaches all of the subject matter upon which the claim depends except for moving the sensing device relative to the document. See also col. 4, lines 22-27 and 37-42.

Lemelson shows moving the document relative to the sensing means. Moving the sensing means relative to a document is well known in the art. Such is the case with bar code type readers, for example.

It would have been obvious to one of ordinary skill in the art to replace or modify the scanner of Lemelson so that the sensor is moved relative to the document such as performed by references well known in the art, i.e., bar codes and other optical readers.

Examiner's Remarks

Applicant's remarks considered at pages 2-4 seemed to be predicated on the absence of the Sept. 12, 2002 office action. A copy of the office action is included with this response.

Applicant indicates at page 5 of the Response that Lemelson does not reproduce a document. The examiner's response is to see figure 5 of Lemelson. Refer to elements 39W and 39X. Applicant's contention is unsupported.

Applicant further contends that Lemelson does not produce a document sheet 21. The examiner traverses this contention based upon 39X as provided in figure 5.

Applicant argues, at page 6, that the examiner contends that document identity and location data are not incorporated in the claims. The examiner reiterates that this specific language is not found in any of claims 1 and 14.

With respect to applicant's comments at the bottom of page 6, applicant contends that a magnetic strip is not coded data. However, the magnetic strip includes coded data and said data is incorporated into the document sheet.

At the bottom of page 7 and bridging the top of page 8, applicant states that the examiner has not responded to the argument regarding the printing step taking place in response to a user input after the magnetic strip is read. The examiner has reviews the arguments and the office action to claim 2, and has not found any language that would support this contention. If the argument is

set forth by applicant, it is not certain the relevancy of such a contention. It does not appear to be related to claim 2.

Based on the arguments presented at pages 2-4, there seems to be confusion as to the limitations argued. Applicant indicated that the communication received Sept. 12, 2002, was lost or never received. Hence, the examiner will not make the application final at this time. With the 9-12-2002 communication submitted at this time, all matters should be clear for applicant to make the best response possible in view of the art rejection outstanding.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

J. Grant II

JEROME GRANT II
PRIMARY EXAMINER